

REMARKS

This amendment is in response to the Office Action dated June 26, 2008. Claims 2 – 6 are in the application upon entry of this amendment; claim 2 stands withdrawn from consideration. Applicants affirm the provisional election of compound A1.001 on page 49 of the specification.

In order to advance the prosecution, the claims have been amended to recite formula **IA** - as opposed to formula I previously. Support for this amendment can be found on page 15, line 1 of the published international patent application where it is indicated that “special preference is given to the compounds of formula IA”. Furthermore, the scope of R₃ and R₄ have been further restricted. Support for this amendment can be found on page 16, where it is indicated that “of the compounds of formula I and especially of the compounds of formula IA, special preference is given in turn to those groups wherein (lines 3-4): k) R₄ is hydrogen, methyl, chlorine or trifluoromethyl (line 21); l) R₃ is C₁-C₃haloalkyl (line 22)”.

Claims 1 and 3 – 5 (now 3 – 6) are rejected under 35 U.S.C 103(a) as being unpatentable over Ruegg (WO 01/54501). Applicants respectfully traverse.

More specifically, the problem addressed by the present invention – as defined by the amended claims – is not simply an “indiscriminate selection” – but rather a specific (non-obvious) selection of alternative herbicidally active nicotinoyl derivatives.

It should be appreciated that while an overlap exists with regard to the (extremely broad) generic scope afforded by Ruegg – the further provision of compounds having a formula IA is not considered obvious in view of it. With regard to compounds of Formula IA it can be seen that the L-W group is located in the 2-position of the pyridine ring. The substantial generic teaching of Ruegg simply suggests (for example) that pyridine ring may be substituted (in an undefined position) with a monocyclic or fused bicyclic ring which may contain from 1 to 4 heteroatoms wherein the ring can be attached to pyridine via, for example, a C₁-C₄ alkylene group. In the specific examples provided by Ruegg the only actual examples provided are wherein the ring is S-linked to the pyridine in the 2-position (e.g S-Ph, SPh and SO₂Ph for example as disclosed in respect of compounds 1.013, 1.014 and 1.015 on page 45). However, Ruegg does not provide any specific examples of molecules comprising an L-W group in the 2-position as taught by the present invention. Accordingly, it is submitted that the substantial generic teaching of Ruegg does not

actually provide any motivation to the skilled person to derive a compound of Formula IA. As such, it is submitted that the subject matter of the amended claims is non-obvious vis-à-vis Ruegg.

Therefore, no prima facie case of obviousness has been made out by the Examiner. With the explanations presented herein, the Examiner is respectfully requested to reconsider the § 103 rejection of the claims.

Applicants submit that the present claims 3 – 6 are allowable over the cited art. Withdrawal of all rejections is respectfully requested, along with issuance of a Notice of Allowance. Applicants invite the Examiner to telephone the undersigned attorney of record if the Examiner feels that the call will be beneficial to advance prosecution of the application.

Respectfully submitted,

USPTO Customer No. 26748
Syngenta Crop Protection, Inc.
Patent and Trademark Dept.
410 Swing Road
Greensboro, NC 27409
(336) 632-7895

/William A. Teoli, Jr./
William A. Teoli, Jr.
Attorney for Applicants
Reg. No. 33,104

Date: November 26, 2008